

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS M. KARAYANNIS, STEVEN A. COHEN,
and JULIE L. LEDERMANN

Appeal No. 1996-1403
Application No. 08/052,574¹

HEARD: October 18, 1999

Before GARRIS, PAK, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 22, 1993. According to appellants, this application is a continuation-in-part of Application No. 07/808,098, filed December 16, 1991, now abandoned.

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claim 1 through 20 which are all the claims in the application.

THE INVENTION

The invention is directed to an alpha olefin polymerization catalyst having a supported catalyst containing Mg and Ti components. The invention requires the presence of from about 0.001 to about 0.6 mole per gram atom of Ti and a first electron donor having the formula set forth in claim 1.

THE CLAIM

Claim 1 is illustrative of appellants invention and is reproduced in the attached appendix.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference.

Arzoumanidis et al.	4,866,022	Sep. 12,
1989		
(Arzoumanidis)		

THE REJECTION

Claims 1 through 20 stand rejected under 35 U.S.C. § 103, as being unpatentable over Arzoumanidis.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we will not sustain the rejection.

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner relies upon a single reference to Arzoumanidis to reject the claimed subject matter. The basic premise of the examiner's rejection is that patentee discloses electron donors that read on those claimed herein. See Answer, page 3. Specifically, the examiner relies upon the disclosure of electron donors by Arzoumanidis in column 5, and 6. The most pertinent disclosure appears in column 5, lines 45 - 57.

Organic electron donors useful in preparation of stereospecific supported catalyst components many times can be organic compounds containing one or more

atoms of oxygen, nitrogen, sulfur, and phosphorous. Such compounds include organic acids, organic acid esters, alcohols, ethers, aldehydes, ketones, amines, amine oxides, amides, thiols and various phosphorous acid esters and amides, and like.

It is the examiner's position that Arzoumanidis differs from the claimed catalyst composition only in the scope of the first electron donor. See Answer, page 3. In contrast, appellants submit that the disclosure of broad categories of compounds is insufficient as a matter of law to establish a prima facie case of obviousness of specified structures. We agree with appellants.

We are not concerned with the name used to designate the relationship between related compounds. It is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound. See In re Payne, 606 F.2d 303, 315, 203 USPQ 245, 254 - 255 (CCPA 1979). In the reference relied upon by the examiner, we find that the only compounds specifically recited by Arzoumanidis are esters of aromatic acids. See column 5, lines 58 - column 6, line 8, and the Examples. We find that esters are excluded from the formula of the claimed subject matter. See the formula together with the definitions of functional groups encompassed

by X and Y. We further find that there is a similar disclosure for a cocatalyst recited by Arzoumanidis at column 8, lines 42 - 50. We conclude however, that none of these disclosures is sufficient to suggest to a person having ordinary skill in the art, the compound having the structure and formula of the claimed subject matter.

"A *prima facie* case of unpatentability requires that the teachings of the prior art suggest the claimed compounds to a person of ordinary skill in the art." See In re Deuel 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). No such suggestion is present in the prior art relied upon herein.

DECISION

The rejection of claims 1 through 20 under 35 U.S.C. § 103, as being unpatentable over Arzoumanidis is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)

Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PAUL LIEBERMAN)	
Administrative Patent Judge)	

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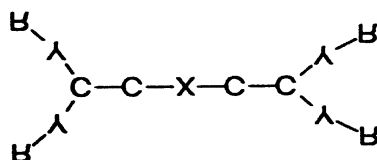
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WALLACE L. OLIVER
AMOCO CORP., PATENTS & LICENSING DEPT.
MAIL CODE 1907A, 200 E. RANDOLPH DRIVE
P.O. BOX 87703
CHICAGO, IL 60680-0703

APPENDIX

Λ διοντες ωαλ ρε C_H⁵ διοντες:

μλγιοθεν' C¹-C⁸ αικλι αυq αικoxλ' αυq C^e-C^a αιλι διοντες' βιονιθεq ιματ ηb ιo ιwo αυq μπειρειν χ αυq λ αιε Η-Η, Ο' Ε(Ο)(ΟΗ), Ε(Ο)Η, οι 2' αυq Η, ιs σελεκτεq ιρω μπειρειν Η ιs σελεκτεq ιρω C¹-C⁸ αικλι, C^e-C^a αιλι οι C¹-C⁸ αικoxλ διοντες:



ωοιe βει δισω ατωμ οi ιιταυιω αυq α ιιτ ιντεμωι ελεκτιου qουoi combuσιuq:

oi coboλwεuσιuoi oi αιβμα-οιετιuε μπιcμ couσιuε ιρω απουt 0.00 ιo απουt 0.ε couσιuιuq, αυbβοτεq cαταλγεt combouεuι ησειuι ιoi ετερεοεδuιeι βολwεuσιuoi ι. Α σοιd, μλγιocαιρω-ιuεoiuβιε, ωαδυεσιuω-couσιuιuq, ιιταυιω-